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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/884,064 | 06/20/2001 | Takehiro Yoshida | 35.C15468 | 1689 |

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EXAMINER

MENBERU, BENIYAM

ART UNIT PAPER NUMBER

2626

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/884,064 | YOSHIDA, TAKEHIRO | |
| | Examiner | Art Unit | |
| | Beniyam Menberu | 2626 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>8/31/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Oath/Declaration

1. Note to applicant: The examiner has received a faxed copy of the stamped postcard and oath in response to the notice to file missing parts. Applicant is advised to submit a non faxed copy.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/865697. Although the conflicting claims are not identical, they are not patentably distinct from each other because both of the claims disclose a facsimile apparatus which can read both-side of an original for transmission. Further they both disclose a reading means, discriminating means for discriminating the existence of effective data on both-side of the original, and

a control means which can either send an image data with both-side or one-side transmission depending on the result of the discrimination means.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Specification

4. The abstract of the disclosure is objected to because it exceeds 25 lines of text and 150 words. Correction is required. See MPEP § 608.01(b).

5. The disclosure is objected to because of the following informalities:

On page 8, line 25, "an RAM" should be "a RAM".

On page 9, line 23, "an ROM" should be "a ROM".

On page 12, line 12, the term "P1" is not defined anywhere in the specification.

On page 32, lines 13-16, "In step S55, a mid-procedure is executed and "0" indicative of a table is transmitted as Page number (PN=3 in case of the front side of the second original sheet in FIG. 16) and Page information." does not agree with the rest of the disclosure since "0" should correspond to the Page information not the Page number, wherein "0" is indicative of a front side is transmitted as Page information.

On page 33, line 26, "an FAX" should be "a FAX".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 8, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 11-17877 to Kido.

Regarding claims 1, 8, and 15, Kido discloses a facsimile apparatus, method (page 11, lines 3-4), and program (page 11, lines 6-8) having a both-side transmitting mode for reading images of original sheets in which both-side and one-side original sheets exist mixedly and transmitting them to a receiver station, comprising:

reading means for reading the images on both sides of the original sheet (page 7, lines 5-8);

means for discriminating whether the images on both sides read by said reading means have effective image information or not (page 7, lines 18-21); and

control means for selectively determining whether a both-side transmitting procedure is used or a one-side transmitting procedure is used, for transmission of the image information on said sides in said both-side transmitting mode, for each transmission of one original sheet, in accordance with a result of the discrimination of said discriminating means (page 8, lines 13-22; page 9, lines 1-2).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2, 3, 4, 5, 7, 9, 10, 11, 12, 14, 16, 17, 18, 19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-17877 to Kido in view of U.S. Patent No. 5815289 to Yoshida et al.

Regarding claims 2, 9, and 16, Kido teaches all the limitations of claims 1, 8, and 15 respectively. However Kido does not disclose an apparatus, method, and program, wherein in said both-side transmitting procedure, both-side transmission control information including a page number and information regarding front or reverse side of the original sheet is transmitted to the receiver station, for each side of the original sheet, and in said one-side transmitting procedure, the transmission of said both-side transmission control information is omitted.

Yoshida et al discloses an apparatus, method, and program (Figure 1B, reference 64), wherein in said both-side transmitting procedure, both-side transmission control information including a page number and information regarding front or reverse side of the original sheet is transmitted to the receiver station, for each side of the original sheet, and in said one-side transmitting procedure, the transmission of said both-side transmission control information is

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omitted (In Figure 22A, when both side is not selected for transmission in step s672, steps s674, s676, s678, s680 follows wherein no information regarding page number or page information is sent. However when both-side is selected in step s672, the flow diagram continues to figure 22B and further to figure 23, figure 24, and figure 25. In figure 24, in step s746 the page information is transmitted for front side and in figure 25, in step s754 page information of back side is transmitted (column 26, lines 48-53, column 26, lines 63-67). Further in figure 26, information regarding front or back-side is added to page information (Figure 26, reference s770, s772; column 27, lines 32-43).).

Kido and Yoshida et al are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the facsimile information submission system of Yoshida et al with the duplex facsimile system of Kido to implement effective transmission of mixed documents.

The motivation to combine the reference is clear because one-sided documents have only one page of information thus it is not necessary to send page information for such transmission but for both-side transmission Yoshida et al teaches that it is necessary to distinguish such transmission using the information that is received (column 49, lines 41-46).

Regarding claims 3, 10, and 17, Kido in view of Yoshida et al teach all the limitations of claims 2, 9, and 16 respectively. Further Yoshida et al disclose an apparatus, method, and program, wherein a count-up operation of said page

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number is executed only with respect to the both-side original sheet of which images on both sides have the effective image information (In figure 24 in step s750 and in figure 25, step s764, page counter is incremented for both sides transmission (Figure 22A, step 672)).

Regarding claims 5, 12, and 19, Kido teaches all the limitations of claims 1, 8, and 15 respectively. Further Yoshida et al disclose an apparatus, method, and program, wherein in said both-side transmitting mode, a both-side transmission in an alternate mode for sequentially transmitting the image information on the front and reverse sides of the original sheets in page order is executed (column 24, lines 56-63).

Regarding claims 7, 14, and 21, Kido in view of Yoshida et al teach all the limitations of claims 2, 9, and 16 respectively. Further Yoshida et al disclose an apparatus, method, and program, wherein assuming that the one-side original sheet is the both-side original sheet, a value to be allocated to the front side is transmitted to the receiver station as a page number of the one-side original sheet (In figure 21B there is a button for selecting both sides original (reference 232). Thus by putting a one-side original and pressing this button, it can be effected as a double side original and referring to figure 22A step s672 this one side original will be treated as double side original and the page number will be transmitted accordingly (Figure 24, step s746; column 23, lines 6-16)).

Regarding claims 4, 11, and 18, Kido teaches all the limitations of claims 1, 8, and 15 respectively. Further Yoshida et al disclose an apparatus, method, and program, wherein all original sheets are transmitted by using said both-side

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transmitting procedure when the number of said one-side original sheets, which do not have effective image information on both sides thereof, is equal to or less than a predetermined value or is equal to or less than a predetermined percentage of the whole number of original sheets (column 49, lines 1-5; column 1, lines 64-67; Yoshida et al teaches that if a one-side is mixed with both-side documents the one-sided documents empty back side will be transmitted, thus both-side transmission is effected for a one-sided document mixed with both-sided documents.).

10. Claims 6, 13, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-17877 to Kido in view of U.S. Patent No. 5815289 to Yoshida et al further in view of U.S. Patent No. 6447113 to Silverbrook et al.

Regarding claims 6, 13, and 20, Kido in view of Yoshida et al teach all the limitations of claims 3, 10, and 17 respectively. However Kido in view of Yoshida et al does not disclose an apparatus, method, and program wherein the count-up operation of said page number is started after it is reset each time the both-side transmitting mode is newly started.

Silverbrook et al disclose a duplex printer which has page counter for duplex pages that is reset when a new document is started, thus this page counter with reset performs the limitations stated in claims 6, 13, and 20 (column 11, lines 60-64).

Kido, Yoshida et al, and Silverbrook et al are combinable because they are in the similar problem area of duplex document processing.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the page counter resetting mechanism taught by Silverbrook et al with the duplex facsimile transmission of Kido in view of Yoshida et al to implement alternative page counters for mixed originals.

The motivation to combine the reference is clear because Silverbrook et al use the page counters for both-sided documents to distinguish odd and even pages and it needs to be reset so that odd and even pages are distinguishable.

Other Prior Art Cited

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5715071 to Takashimizu et al disclose a paper supplier for imaging devices.

U.S. Patent No. 5289290 to Suzuki et al disclose facsimile device with duplex transmission capabilities.

U.S. Patent No. 5282050 to Ishizuka et al disclose an apparatus for recording on both sides in facsimile transmission.

U.S. Patent No. 6160640 to Ohmori disclose image scanner for scanning both sides of documents.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beniyam Menberu whose telephone number is (703) 306-3441. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (703) 306-5631. The group receptionist number for TC 2600 is (703) 305-4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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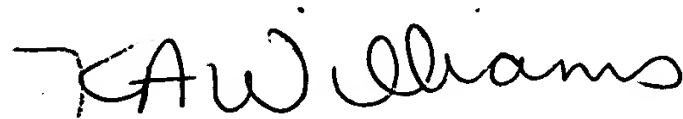
For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner

Beniyam Menberu

BM

02/04/2005

A handwritten signature in black ink, appearing to read "KAW Williams". The signature is written in a cursive, flowing style.

**KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER**